

PATENT APPLICATION

**RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2176**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Ruth E. ROSENHOLTZ et al.

Group Art Unit: 2176

Application No.: 09/682,231

Examiner: Q. TRAN

Filed: August 8, 2001

Docket No.: 110268

For: METHODS AND SYSTEMS FOR TRANSITIONING BETWEEN THUMBNAILS
AND DOCUMENTS BASED UPON THUMBNAIL APPEARANCE

REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the May 2, 2007 Office Action and the June 13, 2007 personal interview, reconsideration of the rejection and objections is respectfully requested in light of the following remarks.

Claims 1-8 are pending.

Applicants thank Examiner Tran for the courtesies extended to Applicant's representatives during the June 13, 2007 personal interview. During the interview, it was agreed that the rejection of claims 1-8 under 35 U.S.C. §103(a) over U.S. Patent Publication No. 2002/0091738 to Rohrbaugh et al. (Rohrbaugh) in view of a publication "Browsers with Changing Parts: a Catalogue Explorer for Philip Glass' Website" by Harry et al. (Harry)

will be withdrawn. It was also agreed that the Final Rejection will be withdrawn, and that the next action will be a Notice of Allowance or a non-final action.

The Office Action rejects claims 1-8 under the judicially created doctrine of obviousness-type double patenting as being upatentable over claims 1-40 of U.S. Patent No. 7,069,506 ('506 patent). This rejection is respectfully traversed.

As discussed during the interview, independent claim 1 is directed to a computer-executable method of displaying a document associated with a thumbnail generated based on an original document, and claim 6 is directed to an apparatus for displaying a document associated with a thumbnail image created based on an original document. On the other hand, the '506 patent is directed to a method for generating an enhanced thumbnail associated with a document. None of the claims of the '506 patent recite displaying a first version of the original document, at least a portion of the first version corresponding to the enhancement being more similar in visual appearance to a corresponding portion of the thumbnail than a corresponding portion of the original document based on comparison of the at least a portion of the first version of the corresponding portion of the original document and the corresponding portion of the thumbnail, as recited in claims 1 and 6 of the present application.

As discussed during the interview, because the claims of the '506 patent are not directed to a method of or an apparatus for displaying a document as associated with a thumbnail and do not recite the features of claims 1 and 6 of the present application, as recited in claims 1 and 6, claims 1-8 of the present application would not have been obvious from the claims of the '506 patent. As such, withdrawal of the double patenting rejection is respectfully requested.

The Office Action rejects claims 1-8 under 35 U.S.C. §103(a) over Rohrbaugh in view of Harry. This rejection is respectfully traversed.

Rohrabaugh is a continuation-in-part application of U.S. Patent Serial No. 09/828,511 filed July 7, 2001, which is a non-provisional application of Provisional Application No. 60/211,019 filed June 12, 2000. However, as discussed and agreed to during the June 13, 2007 personal interview, the provisional application of Rohrabaugh does not sufficiently disclose the subject matter of Rohrabaugh. Therefore, July 7, 2001 is the effective filing date of Rohrabaugh.

As evidenced by the Declaration Under 37 C.F.R. §1.131 filed April 12, 2005, the invention of the present application was invented by the inventors prior to March 20, 2001. Therefore, as agreed to during the interview, Rohrabaugh does not qualify as prior art under 35 U.S.C. §103(a).

Harry is merely relied on as teaching displaying a first version of the original document and does not overcome the deficiencies of Rohrabaugh. Accordingly, claims 1-8 are patentable over Rohrabaugh and Harry.

As such, withdrawal of the rejection is respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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JAO:LMS/hms

Date: June 15, 2007

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